

REMARKS

This Amendment is submitted in response to the Office Action dated August 11, 2005. In the Office Action, the Patent Office objected to the disclosure due to informalities. Further, the Patent Office objected to Claim 12 as being of improper dependent form for failing to further limit the subject matter of a previous claim. Still further, Claim 18 is objected to because of informalities. Moreover, the Patent Office rejected Claim 8 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Furthermore, the Patent Office rejected Claims 1, 4-8 and 11-15 under 35 U.S.C. §102(b) as being anticipated by *Mathys* (Patent No. CH 668,380). In addition, the Patent Office rejected Claims 1, 3, 7 and 9 under 35 U.S.C. §102(b) as being anticipated by *Keddie* (U.S. Des. 393,578). Further, the Patent Office rejected Claims 2 and 10 under 35 U.S.C. §103(a) as being unpatentable over *Mathys* in view of *Burk et al.* (U.S. Patent No. 6,314,841); and rejected Claims 16-20 under 35 U.S.C. §103(a) as being unpatentable over *Mathys* in view of *Gramera et al.* (U.S. Patent No. 5,048,379).

By the present Amendment, Applicant amended the disclosure and amended Claims 1, 7, 12, 14, 16 and 18. Applicant submits that the amendments to the claims overcome the rejections by the Patent

Office and places the application in condition for allowance. Notice to that effect is respectfully requested.

Applicant corrected the first full paragraph of page 9 to change "side 21" and "side 25" to "wall 21" and "wall 25" as referenced in the other pages of the specification. Further, Applicant corrected the first full paragraph of page 9 to clarify that track 6g was not being separated from itself. Further, Applicant corrected pages 13 and 14 of the specification by changing any reference to "wrenches 1, 50" to "wrenches 1 and 50". Applicant submits that no new matter is added to the application by the amendments to the specification. Notice to that effect is requested.

Furthermore, the Patent Office objected to Claim 12 as being of improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, the Patent Office alleges Claim 12 appears to be the same as independent Claim 7. Applicant submits that the amendment to Claim 12 overcomes the objection. Notice to that effect is requested.

With respect to the rejection of Claim 8 under 35 U.S.C. §112, second paragraph, Applicant amended Claim 8 by changing "size" to "length" incorporating the suggestion of the Patent Office. Applicant submits that the amendment to Claim 8 overcomes the rejection. Notice to that effect is requested.

With respect to the rejection of Claims 1, 4-8 and 11-15 under 35 U.S.C. §102(b) as being anticipated by *Mathys*, Applicant submits that this rejection has been overcome by the amendment to Claims 1, 7, 12 and 14 and for the reasons that follow.

In the Office Action, the Patent Office alleges:

In reference to Claim 1, *Mathys* discloses a tool comprising a body having an outsider perimeter and an inside perimeter wherein the insider perimeter defines an open area, first surfaces around the open area and second surfaces around the inside perimeter wherein the second surfaces are parallel and separated by a second width wherein the second width is greater than the first width and [stat] the first surfaces is coextensive with one of the second surfaces.

In reference to Claim 7, *Mathys* further discloses a fastening device comprising a body defined between a first end and a second end wherein the body has an outside perimeter, an interior area within the body having a first wall parallel to a second wall and indents within the first wall and the second wall wherein the indents divide the first wall and the second wall into sections and wherein a width between the first wall and the second wall increases from the first end to the second end.

In reference to Claim 14, *Mathys* inherently discloses a method for securing a fastener, the method comprising the steps of providing a tool having a body defined between a first end and a second end wherein the body has an interior area defined between a first end and a second end wherein the body has an interior area defined by parallel walls wherein the walls have engaged sections wherein the engaging sections are co-extensive and further wherein each of the engaging sections wherein engaging sections are co-extensive and further wherein each of the engaging sections has a different width separating the engaging sections in the interior area and selecting first engaging sections to contact the fastener wherein the walls of the tool contact the fastener.

Independent Claim 1, as amended, requires that the height has a maximum height at the first end and that the height decreases to

a minimum height at the second end. Further, amended Claim 1 requires that the height undulates between the first end and the second end.

Independent Claim 7, as amended, requires that the height undulates between the first end and the second end. Further, amended Claim 7 requires that the first wall is continuously parallel to the second wall. Still further, Claim 7, as amended, requires that the first width increases to form a greater area between the spaced sections as the distance from the first end increases.

Independent Claim 14, as amended, requires that the width of the engaging sections increases along the length from a minimum width at the first end to a maximum width at the second end. Further, amended Claim 14 requires that the height increases along the length of the tool from a minimum height at the first end to a maximum height at the second end.

On the contrary to that defined by amended Claims 1, 7 and 14, Mathys merely discloses a device having two heads to accommodate different sized bolt heads. Each head has an opening. The openings are symmetrical with respect to a central axis. In addition, Mathys discloses a central section connecting the first head to the second head. The central section has a third opening.

Nowhere does *Mathys* disclose that the height has a maximum height at the first end and that the height decreases to a minimum height at the second end, as required by independent Claim 1, as amended. Further, nowhere does *Mathys* disclose that the height undulates between the first end and the second end, as required by amended Claim 1. *Mathys* merely discloses a device having two symmetrical heads which are joined by a central section. The symmetrical heads increase in height from the central section in opposing directions. The central section has a separate opening which has a minimum height. Therefore, nowhere does *Mathys* disclose the tool as defined by amended Claim 1.

Nowhere does *Mathys* disclose that the height undulates between the first end and the second end, as required by independent Claim 7, as amended. Further, nowhere does *Mathys* disclose that the first wall is continuously parallel to the second wall, as required by amended Claim 7. Still further, nowhere does *Mathys* disclose that the first width increases to form a greater area between the spaced sections as the distance from the first end increases, as required by Claim 7, as amended. *Mathys* merely discloses a device having multiple openings. The openings are defined by walls that are perpendicular to the exterior surface of the device. Therefore, nowhere does *Mathys* disclose a fastening device as defined by independent Claim 7, as amended.

Moreover, nowhere does Mathys disclose that the width of the engaging sections increases along the length from a minimum width at the first end to a maximum width at the second end, as required by Claim 14, as amended. Further, nowhere does Mathys disclose that the height increases along the length of the tool from a minimum height at the first end to a maximum height at the second end, as required by Claim 14, as amended. Mathys merely discloses a device having two symmetrical heads which are joined by a central section. The device has three openings having three interior areas. Therefore, nowhere does Mathys disclose the method for securing a fastener as defined by Claim 14, as amended.

Under 35 U.S.C. §102, anticipation requires that a single reference disclose each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d. 1241, 1245 (Fed. Cir. 1986). Moreover, anticipation is not shown even if the differences between the claims and the references are "insubstantial" and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 USPQ 1264, 1270 (Fed. Cir. 1984).

In view of the foregoing, since Mathys fails to disclose each and every element of amended independent Claims 1, 7 and 14, the rejection of Claims 1, 4-8 and 11-15 under 35 U.S.C. §102(b) has

been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 1, 3, 7 and 9 under 35 U.S.C. §102(b) as being anticipated by *Keddie*, Applicant respectfully submits that the rejection has been overcome by the amendment to independent Claims 1 and 7 and for the reasons that follow.

In the Office Action, the Patent Office asserts:

In reference to Claim 1, *Mathys* discloses a tool comprising a body having an outsider perimeter and an inside perimeter wherein the inside perimeter defines an open area, first surfaces around the open area wherein the first surfaces are parallel and separated by a first width in the open area and second surfaces around the inside perimeter wherein the second surfaces are parallel and separated by a second width wherein the second width is greater than the first width and one the first surfaces is co-extensive with one of the second surfaces.

In reference to Claim 7, *Mathys* discloses a fastening devise comprising a body defined between a first end a second end wherein the body has an outside perimeter, an interior area within the body having a first wall parallel to a second wall and indents within the first wall and the second wall wherein the indents divide the first wall and the second wall into section and wherein a width between the first wall and the second wall increases from the first end to the second end.

Independent Claim 1, as amended, requires that the height has a maximum height at the first end and that the height decreases to a minimum height at the second end. Further, amended Claim 1 requires that the height undulates between the first end and the second end.

Independent Claim 7, as amended, requires that the height undulates between the first end and the second end. Further, amended Claim 7 requires that the first wall is continuously parallel to the second wall. Still further, Claim 7, as amended, requires that the first width increases to form a greater area between the spaced sections as the distance from the first end increases.

On the contrary to Applicant's invention defined by amended Claims 1 and 7, Keddie merely discloses a compound wrench having two heads to accommodate different sized bolt heads. Each head has an opening. The openings are symmetrical with respect to a central axis.

Nowhere does Keddie disclose that the height has a maximum height at the first end and that the height decreases to a minimum height at the second end, as required by independent Claim 1, as amended. Further, nowhere does Keddie disclose that the height undulates between the first end and the second end, as required by amended Claim 1. Keddie merely discloses a device having two symmetrical heads which are joined by a central section. The symmetrical heads increase in height from the central section in opposing directions. Therefore, nowhere does Keddie disclose the tool as defined by amended Claim 1.

Nowhere does Keddie disclose that the height undulates between the first end and the second end, as required by independent Claim

7, as amended. Further, nowhere does Keddie disclose that the first wall is continuously parallel to the second wall, as required by amended Claim 7. Still further, nowhere does Keddie disclose that the first width increases to form a greater area between the spaced sections as the distance from the first end increases, as required by Claim 7, as amended. Keddie merely discloses a device having two openings. The openings increase as the openings approach the center section. Therefore, nowhere does Keddie disclose a fastening device as defined by independent Claim 7, as amended.

Under 35 U.S.C. §102, anticipation requires that a single reference disclose each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d. 1241, 1245 (Fed. Cir. 1986). Moreover, anticipation is not shown even if the differences between the claims and the references are "insubstantial" and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 USPQ 1264, 1270 (Fed. Cir. 1984).

With respect to the rejection of Claims 2 and 10 under 35 U.S.C. §103(a) as being unpatentable over Mathys in view of Burk et al., Applicant submits that this rejection has been overcome in view of the amendment to independent Claims 1 and 7 and for the reasons that follow.

In the Office Action, the Patent Office alleges:

Mathys discloses the fastening devise as discussed supra but fails to disclose that there are grooves on the body of the tool wherein the grooves (18A in ribs 18) along the outer edge of the tool, wherein the grooves provide an excellent structure for allowing the hand tool to be gripped by the human hand (col. 2, lines 18-29). Therefor, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the body of the Mathys invention with grooves extending toward the inside of the body, toward the inside perimeter, to provide an excellent structure for allowing the hand tool to be gripped by the human hand, as taught by Burk.

However, Claim 2 requires grooves in the body of the tool wherein the grooves extend toward the inside perimeter. On the contrary, *Burk et al.*, fail to teach or to suggest the elements of the present invention which are not taught by *Mathys*, as required by amended independent Claim 1 from which Claim 2 depends. Accordingly, the rejection of Claim 2 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claim 10 requires grooves formed in the body of the fastening device wherein the grooves extend toward the interior area. On the contrary, *Burk et al.*, fail to teach or to suggest the elements of the present invention which are not taught by *Mathys*, as required by amended independent Claim 7 from which Claim 10 depends. Accordingly, the rejection of Claim 10 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

With respect to the rejection of Claims 16-20 under 35 U.S.C. §103(a) as being unpatentable over Mathys in view of Gramera et al., Applicant respectfully submits that the rejection has been overcome by the amendment to independent Claim 16 and for the reasons that follow.

In the Office Action, the Patent Office alleges:

In reference to claim 16, Mathys discloses a tool comprising a body having an outside perimeter and an inside perimeter and an inside perimeter wherein the first surfaces are parallel and opposed, and second surfaces within the inside perimeter wherein the second surfaces are parallel and opposed and wherein the second surfaces are separated by a distance greater than the distance between the first surfaces and further wherein on of the first surfaces is co-extensive with one of the second surfaces. Mathys, however, fails to disclose a first section and a second section along each of the first surfaces wherein a first distance exists between opposed first sections and a second distance exists between opposed second sections wherein the first distance is not equal to the second distance and that the second surfaces are separated by distance greater than the first distance and the second distance. Gramera discloses multi-functional double ended socket wrenches wherein each socket has one side with an English standard size and an opposite side with the closest equivalent metric size, both of which are larger than the English standard size and an opposite side with the closest equivalent metric size, both of which are larger than the English standard and metric sizes of the prior socket (Table 1). Both Mathys and Gramera teach that including more than one sized wrench into a single tool will minimize clutter and weight of tool storage (such as tool boxes) and will make projects requiring different sized wrenches easier, by reducing the time to find different sized wrenches easier, by reducing the time to find different sized wrenches to fit each different sized fastener.

Independent Claim 16, as amended, requires that the exterior surface undulates between the first end and the second end.

Further, amended Claim 16 requires that the distance between the second surfaces increases as the second surfaces move toward the first end. Still further, Claim 16 requires that the distance is at a maximum length at the second end.

Contrary to the invention defined by amended Claim 16, *Gramera et al.* merely teach double end, hollow core socket wrenches. The socket wrenches have an English unit socket on one end and a metric size socket wrench on the opposing side.

Neither *Mathys* nor *Gramera et al.*, taken singly or in combination, teaches or suggests that the exterior surface undulates between the first end and the second end, as required by Claim 16, as amended. Further, neither *Mathys* nor *Gramera et al.*, taken singly or in combination, teaches or suggests that the distance between the second surfaces increases as the second surfaces move toward the first end, as required by amended Claim 16. Still further, neither *Mathys* nor *Gramera et al.*, taken singly or in combination, teaches or suggests that the distance is at a maximum length at the second end, as required by Claim 16, as amended.

In fact, *Gramera et al.* and *Mathys*, taken singly or in combination, teach away from the present invention as defined by Claim 16. Both *Gramera et al.* and *Mathys* teach interior areas which increase as the interior areas move away from the center section. Therefore, neither *Mathys* nor *Gramera et al.*, taken

singly or in combination, teaches or suggests the tool as defined by amended Claim 16. Moreover, a person of ordinary skill in the art would never have been motivated to combine *Mathys* and *Gramera et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). More specifically, Applicant submits that the Patent Office is merely "piece-mealing" references together, providing various teachings and positively defined limitations of Applicant's tool to deprecate the claimed invention. Of course, hindsight reconstruction of Applicant's invention is impermissible. Applicant respectfully submits that Claim 16 distinctly defines the present invention from *Mathys* and *Gramera et al.*, taken singly or in combination.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all of the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made.

Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1986).

With the analysis of the deficiencies of *Mathys* and *Gramera et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art would have been led to modify *Mathys* with *Gramera et al.* to produce the claimed invention. Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103. Accordingly, the rejection of Claims 16-20 under 35 U.S.C. §103(a) has been overcome and should be withdrawn. Notice to that effect is requested.

Claims 2-6 depend from independent Claim 1; Claims 8-15 depend from independent Claim 7; and Claims 17-20 depend from independent Claim 16. These claims are also believed allowable over the references of record for the same reasons set forth with respect to their parent claims since each sets forth additional structural elements of Applicant's fastening device. Notice to that effect is requested.

In view of the foregoing remarks and arguments, Applicant respectfully submits that all of the claims in the application are in allowable form and that the application is in condition for allowance. If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

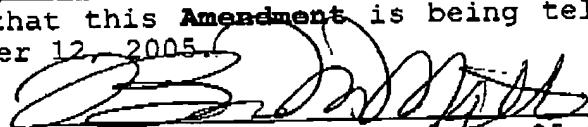


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CERTIFICATE OF TELEFAX

I hereby certify that this Amendment is being telefaxed to (571) 273-8300 on December 12, 2005.



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